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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/763,723 | 02/27/2001 | Helen Biddiscombe | 6001-011 | 3720 |

29381 7590 12/29/2003

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| EXAMINER |
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BRUENJES, CHRISTOPHER P

| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 12/29/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,723

Applicant(s)

BIDDISCOMBE, HELEN

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2003 has been entered.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 103 rejections of claims 1-10 over Rackovan et al of record in Paper #5, Page 4 Paragraph 7 have been withdrawn due to Applicant's arguments in Paper #14.

3. The 35 U.S.C. 103 rejections of claims 13-15 over Rackovan et al of record in Paper #11, Pages 3-4 Paragraph 5 have been withdrawn due to Applicant's arguments in Paper #14.

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4. The 35 U.S.C. 103 rejection of claim 12 over Rackovan et al in view of Takagi of record in Paper #11, Pages 4-5 Paragraph 6 has been withdrawn due to Applicant's arguments in Paper #14.

REPEATED REJECTIONS

5. The 35 U.S.C. 102 rejections of claims 1-8 and 10 as anticipated by Takagi are repeated for the reasons previously of record in Paper #5, Page 3 Paragraph 5 and Paper #11, Pages 5-6 Paragraph 8.

Regarding the newly submitted limitation to claim 1, Takagi teaches at least one layer being formed of polypropylene, which is a polyolefin (col.3, 1.25-30).

NEW REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-15 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 14, the limitation "intermediate layer" in line 6 renders the claim indefinite because it is not understood how a hose can have an intermediate layer and not have a layer on either side of the intermediate layer. Two layered articles cannot have an intermediate layer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4-7, 9, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsura et al (USPN 5,223,315).

Katsura et al anticipate an in-mold labeled, blow-molded article (see abstract). The article or bottle is formed from high density polyethylene (col.9, 1.1-10 and 1.36-50). The label being formed from a biaxially oriented polypropylene based film having shrinkage in the machine direction of 6% and the transverse direction of 5% (Table 1, example 12 in columns 23 and 24). The film contains at least one layer, and at least one layer is a polyolefin layer, such as the biaxially oriented

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polypropylene based film itself. The film further comprises a heat sealable adhesive polymer layer as the outer layer, such as ethylene-vinyl acetate (Table 1, example 12 in columns 23 and 24). As shown in Figure 1-F, the label further comprises an overcoat layer (reference number 6, Fig. 1-F), which is an intermediate layer between the polypropylene base layer (reference number 2, Fig. 1-F) and the outer adhesive layer (reference number 4, Fig. 1-F). The overcoat layer or intermediate layer is formed from polypropylene, which is a polyolefin (col.15, 1.48-55). The intermediate layer incorporates inorganic beads (col.12, 1.38-40), which are voiding agent filler.

7. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Leatherman et al (USPN 4,892,779).

Leatherman et al anticipate a multilayer article, such as an in-mold label for labeling of polyolefin containers such as high density polyethylene containers (col.14, 1.19-35). The label is formed from a biaxially oriented polypropylene based film formed from at least one layer of polypropylene, which is a polyolefin (col.13, 1.4-7 or col.1, 1.20-35). The biaxially oriented films have shrinkage of greater than 6% in both machine direction and the transverse direction (Table V, col.19). The

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multilayer article comprises at least one layer of microporous material and at least one layer of nonporous material (col.13, 1.45-51). The nonporous material is formed from polypropylene as shown above, which is a polyolefin and heat sealable. The microporous material is formed from ultrahigh molecular weight polypropylene with void containing filler (col.1, 1.20-35). The microporous material is taught to be at least in the multilayered article as at least one layer. In the embodiment in which the microporous material is in more than one layer, the microporous material is the base layer and an intermediate layer, while the nonporous material is at least an outer layer. The microporous material layers further comprise organic extraction liquids including 1,2-dichloroethane, 1,1,1-trichloroethane or 1,1,2-trichloroethane (col.7, 1.50-56). Saturated hydrocarbons such as chloroethanes are structurally equivalent to hydrocarbons that are fully hydrogenated because they do not contain any higher bonds than a single bond. Therefore, Leatherman et al anticipates a base layer and intermediate layer containing a hydrogenated hydrocarbon resin.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura et al (USPN 5,223,315).

Katsura et al teach all that is claimed in claim 1 and teaches that the shrinkage in the transverse direction is at least 5%, but fails to explicitly teach an example, in which the shrinkage in the transverse direction is 6% or greater. However, Katsura teaches that the thermal shrinkage of a label for in-mold labeling is greater than the thermal shrinkage of

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the bottle or container the label is applied to, in order to prevent crease and swelling of the label during labeling operation inside the mold and adhesion and peel-resistance between the label and the container outer surface is improved (see abstract). Katsura also teaches that containers formed from high-density polyethylene have heat shrinkage factors from 2 to 5% (Table 1, Column 9). One of ordinary skill in the art would have recognized that an in-mold label applied to a container formed from high-density polyethylene having a heat shrinkage factor of 5%, would have shrinkage in both the machine and transverse directions of about 6%, since in order to prevent crease and swelling of the label and to enhance adhesion and peel-resistance between the label and the container the shrinkage of the label must be greater than the container the label is applied to, as taught by Katsura et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to form the label having shrinkage in the transverse direction of at least 6%, in order to prevent crease and swelling of the label and enhance adhesion to the container, when applying the label to a container with a high shrinkage factor such as high-density polyethylene containers, as taught by Katsura et al.

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9. Claims 8, 10, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura et al (USPN 5,223,315) in view of Takagi (USPN 5,078,817).

Katsura et al teach all that is claimed in claims 6 and 9 as shown above, but fail to explicitly teach adding a hydrogenated hydrocarbon to the base and/or intermediate layers. However, Takagi teaches that hydrogenated hydrocarbon resins are used in the layers of shrinkage labels, in order to enable the shrinking power of the film to occur uniformly so that deformation of the label does not occur (col.5, 1.9-20). One of ordinary skill in the art would have recognized that hydrogenated hydrocarbon resins are added to the layers of labels having shrinkage, in order to uniformly distribute the shrinking power of the film so that deformation of the label does not occur, as taught by Takagi.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add the hydrogenated hydrocarbon resins of Takagi to the base layer and intermediate layer of Katsura et al in order to prevent deformation of the label, as taught by Takagi.

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-8 and 10 as anticipated by Takagi have been considered but are not persuasive.

In response to the applicant's argument that Takagi teaches wrap-around labeling and the instant invention teaches in-mold labeling, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation receives little patentable weight. Article claims are defined strictly by structural limitations and not how the articles are formed because more than one process can be used to form the same article. As the instant invention is claimed, Takagi anticipates all of the structural limitations, because with comprising language the structure of the wrap-around label of Takagi is the same as the in-mold label of the instant invention.

11. Applicant's arguments regarding the 35 U.S.C. 103 rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foulkes (USPN 5,868,986).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

December 23, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

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